



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,759	01/30/2002	Adam Lerner	701586/50174-DIV	8480

7590 11/01/2004

Ronald I Eisenstein  
Nixon Peabody LLP  
100 Summer Street  
Boston, MA 02110

EXAMINER
----------

SPIVACK, PHYLLIS G

ART UNIT	PAPER NUMBER
----------	--------------

1614

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/060,759

Applicant(s)

LERNER, ADAM

Examiner

Phyllis G. Spivack

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1-30-02</u> . | 6) <input type="checkbox"/> Other: _____  |

Applicant's Responses to the request for an election of species filed April 23, 2004 and August 11, 2004 are acknowledged. 4-(3-Butoxy-4-methoxybenzyl)-2-imidazolidinone, also known as Ro-1724, is the elected specie. New claim 15 is presented in the second Response. Claims 1-7 and 15 are pending.

A Preliminary Amendment filed January 30, 2002 is acknowledged in which priority information is established and claims 8-14 are canceled.

An Amendment filed June 4, 2002 is acknowledged in which sequence identifiers for the sequence listing simultaneously submitted are presented.

An Information Disclosure Statement filed January 30, 2002 is further acknowledged and has been reviewed

The election is made with traverse. Applicant urges type 4 cyclic adenosine monophosphate inhibitors in general are useful in the present invention. It is Applicant's position that multiple PDE4 inhibitors work in the present invention.

Applicant's position has been given careful consideration. A search beyond the elected specie will be conducted subsequent to Applicant's submission of a reasonable number of species that are encompassed in the subject disclosure.

The elected species appears to be free of the prior art. The search has been extended according to current Markush practice.

. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,399,649. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the patented claims is encompassed in the present claims.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the administration of rolipram and 4-(3-Butoxy-4-methoxybenzyl)-2-imidazolidinone, does not reasonably provide enablement for any type 4 cyclic adenosine monophosphate inhibitor. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. In view of the well established unpredictability of treating chronic lymphocytic leukemia, one skilled in the hematology art would not reasonably expect any and all type 4 cyclic adenosine monophosphate inhibitors to be therapeutically efficacious.

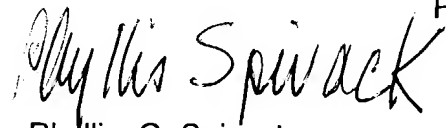
Claim 15 appears to be free of the prior art.

Any inquiry concerning this communication should be directed to Phyllis G. Spivack at telephone number 571-272-0585.

Application/Control Number: 10/060,759

Art Unit: 1614

Page 4

A handwritten signature in black ink, reading "Phyllis Spivack". The signature is written in a cursive style with a large, stylized "P" and "S".

Phyllis G. Spivack

Primary Examiner

Art Unit 1614

October 28, 2004

**PHYLLIS SPIVACK  
PRIMARY EXAMINER**